

Application No. 09/878,165**Attorney Dkt. No: 30015420-2US (1509-186)****BEST AVAILABLE COPY****REMARKS**

The Office Action of September 7, 2005 has been considered in detail, and Applicants' hereby submit their comments to the Office Action below.

The indication of claims 2, 6, 8, 98, 11, 18, 20 and 21 containing allowable subject matter is noted.

Claims 15 and 16 are hereby cancelled. These claims are cancelled because Applicants believe that, under present PTO guidelines, the subject matter thereof does not comply with 35 U.S.C. §101. Applicants do not agree with the rationale set forth in the Office action that claims 15 and 16 are anticipated under 35 U.S.C. §102(b) by Bolan et al., U.S. Patent 5,226,137. Consequently, canceling these claims in not to be construed as an admission by Applicants that the relied on portions of Bolan et al. disclose data defining an amount of data storage capacity licensed for use by a computer entity. There is no specific disclosure of such a feature in the relied on portion of Bolan et al., and the Office Action fails to provide adequate rationale or evidence to support the conclusion that the secured data file includes such data.

Rejections under 35 U.S.C. §103

Applicants traverse the rejection of claims 12-14 and 22 as being unpatentable over Bolan et al., U.S. Patent 5,226,137, in view of Westfall et la., U.S. Patent 5,155,849. The Office Action admits Bolan et al. fails to describe the claim 12 requirements of receiving a request to modify the data storage capacity of a computer entity, checking whether the data storage capacity of the computer entity can be modified, and enabling the data storage capacity of the computer entity to be modified if the checked data indicate the capacity can be modified. Applicants can not agree with the conclusion in the Office

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Action that it would have been obvious from column. 8, line 58 - to column. 9, line 36 of Westfall et al. to include the admitted missing features of claim 12 in the Bolan et al. arrangement.

Westfall et al. describes a photocopier that is operated by using a user interface. The user interface includes a touch-screen display that displays both text and graphics for operating the machine; see column 2, lines 55-60. Control software of the Westfall et al. photocopier includes two language files to control the language of the text displayed on the user interface. By selecting a different language file, the user is able to change the language of the display between a primary language and a secondary language; see column 7, line 63 - column 8, line 2.

The control software of the photocopier can be fully or partially upgraded. In a full upgrade, all files of the control software are replaced; in a partial upgrade, only selected files are replaced, e.g. the primary or secondary language files; see column 8, lines 17-34.

The software upgrade has two phases. In the first phase, a service engineer responsible for upgrading the photocopier enters an upgrade mode via the user interface, e.g. by selecting a full, incremental or partial upgrade. Once the type of upgrade has been selected, the service engineer is requested to insert a first floppy disk of an upgrade kit into the photocopier. The photocopier control software then determines (1) the upgrade version of the upgrade kit and (2) the upgrade kit floppy disks required to perform the upgrade. Before the upgrade commences, the control software writes several pieces of information to a hard disk of the photocopier. In particular, an upgrade-in-progress flag is written to the hard disk. If the upgrade is subsequently interrupted, normal operation of the photocopier is prevented until the upgrade has been completed. A software upgrade tool resident on the floppy disk is then read and executed to commence the second phase of the upgrade; see column 8, line 58 - column 9, line 8.

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In the second phase, the software upgrade tool installs all necessary files from the floppy disks of the upgrade kit to the photocopier hard disk. When completed, the software upgrade tool removes the upgrade-in-progress flag. Finally, the service engineer turns off the photocopier, removes the floppy disk, and turns on the photocopier to cause photocopier to use the newly installed software.

In summary, files on the floppy disk(s) are copied to the hard disk of the photocopier to overwrite older versions of the files previously present on the hard disk. At no time, however, does Westfall et al. disclose the claim 12 requirement for including modification of the data storage capacity of a computer entity, i.e., in the case of Westfall et al., the hard disk data capacity is not modified.

The Examiner alleges it would have been obvious to one of ordinary skill to modify Bolan et al. as a result of Westfall et al., because one of ordinary skill would have selectively installed customer language options in the field, as required, to be able to provide a simple means for switching language displays during or after installation of the machine at the customer site. It is not entirely clear what the Examiner is intending to imply with this statement. Therefore, if this position is repeated, clarification of the Examiner's rationale is in order.

The Bolan et al. memory stick is an integrated circuit having a memory array for storing secure data (column 2, lines 50-55). Bolan et al. has no disclosure of the memory stick storing software for controlling the operation of the memory stick. Instead, operation of the memory stick is performed purely by an integrated circuit as described at column 10, line 37 through column 13, line 11, and illustrated in Figures 20-25. Therefore, it is not obvious to upgrade Bolan et al. by transferring files to the memory stick.

It is therefore submitted that the subject-matter of claim 12 is not rendered obvious by the combination of Bolan et al. and Westfall et al.

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Westfall et al. fails to disclose increasing the storage capacity of the hard disk of the photocopier. There is no basis in the relied on portions of Westfall et al. to suggest the statement in the Office Action that the Westfall et al. 'upgrade-in-progress flag' increases the amount of accessible storage space on the hard disk of the photocopier. The upgrade-in-progress flag is, instead, used merely to indicate that the contents (not the capacity) of the hard disk are being updated. If the upgrade were interrupted and an attempt were then made to use the photocopier, the control software on the hard disk would comprise both old and new files and consequently the photocopier might not operate correctly; see column 9, lines 37-42. Accordingly, normal operation of the photocopier is prevented while the upgrade-in-progress flag is stored on the hard disk. After a successful upgrade has been completed, the upgrade-in-progress flag is removed from the hard disk; see column 9, lines 21-28. The upgrade-in-progress flag does not therefore modify the storage capacity of the hard disk of the photocopier. While normal operation of the photocopier is prevented if an upgrade-in-progress flag is present, the upgrade-in-progress flag does not prevent access to the hard disk of the photocopier. In particular, the software upgrade tool is able to write files to the hard disk of the photocopier regardless of whether or not the upgrade-in-progress flag is present. The storage capacity of the hard disk is not therefore modified by the presence of the upgrade-in-progress flag.

The Office Action relies on column 5, line 5 – column 6, line 67 of Bolan et al to disclose the claim 22 requirements to increase the memory capacity by responding to an obtained license. However, there is nothing in the portion of Bolan et al. disclosing a license being linked to memory capacity, no less to increased memory capacity. If the Examiner persists in this rejection, he must explain a nexus between the Bolan et al. disclosure with increased memory capacity and a license.

As already noted, Westfall et al. disclose modifying the contents of a data storage device. However, Westfall et al. does not disclose a method of modifying the capacity of a data storage device.

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Applicants traverse the rejection of claims 1, 3-5, 7 10 and 17 as being obvious as a result of the combination of Bolan et al., Westfall et al. and Dubats, U.S. Patent 5,59,496 [sic], apparently, U.S. Patent 5,559,496.

To reject claim 1, the Examiner states that Bolan et al. describes a data storage device and first license key data that allows partitioning of the data storage device. The examiner regards the ID field of each secure subkey of the memory stick as license key data that meets the claim requirements allows partitioning of a storage device to provide a first amount of licensed data storage capacity that is larger than the total amount of data capacity of the data storage device.. This allegation about Bolan et al. is incorrect.

The Bolan et al. memory stick comprises an integrated circuit that includes a memory array. The memory array is partitioned by the integrated circuit into three secure areas (referred to by Bolan et al. as secure subkeys) and one insecure area (referred to by Bolan et al. as a scratch pad). Each secure subkey of the memory array is sub-divided by the integrated circuit into three parts: an ID field, a password field and a secure data field (col. 5, lines 6-8). To read data from or write data to the secure data field of each secure subkey, a command is supplied to the memory stick. The command (e.g., set secure data or get secure data) includes both the ID and the password of the relevant secure subkey. In this way, the contents of each secure subkey can be accessed only when the correct ID and password are provided (col. 5, lines 25-45).

The ID fields therefore store data that uniquely identify each secure subkey of the memory stick, i.e., the ID fields store data that uniquely identify each partition of the memory array. The ID field does not, however, store data that allows partitioning of the memory array. Instead, the memory array is physically partitioned in the integrated circuit. Moreover, the physical integrated circuit partitions the memory array to create the ID field, password field and secure data field of each subkey. Data stored in

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each ID field are therefore stored only after partitioning has occurred. There is no disclosure of data stored in each ID field being used to partition the memory array to provide a first amount of licensed data storage capacity. The Examiner must explain how each ID field stores license key data that allow the memory array of the memory stick to be partitioned.

The Examiner concedes Bolan et al. fails to disclose upgrade flag data, but incorrectly says this feature is disclosed by Westfall et al. The Westfall et al. upgrade-in-progress flag is written to a photocopier hard disk during an upgrade of the control software. Consequently, should the upgrade be interrupted, normal operation of the photocopier is prevented until such time as the upgrade has been completed, at which point the upgrade-in-progress flag is removed. The upgrade-in-progress flag therefore provides an indication that an upgrade of software stored on a hard disk is in process. The upgrade-in-progress flag does not, however, determine whether the capacity of the hard disk can be increased. Westfall et al. therefore fails to disclose upgrade flag data that determines whether the storage capacity of a data storage device can be increased.

Repartitioning of the memory array of Bolan et al. cannot occur without physically modifying the Bolan et al. integrated circuit. Applicants do not understand how the Bolan et al. memory array can be repartitioned by writing data to the fields of each subkey (e.g. by writing data to the ID field, password field or secure data field). Accordingly, Applicants do not understand how the capacity of a particular subkey can be increased by writing data to the subkey. As a result, Applicants do not understand how, if a person of ordinary skill were to write an upgrade-in-progress flag to the memory array of Bolan et al., the upgrade-in-progress flag would change the storage capacity of each of the partitions of the memory array. Explanation is in order if this position is repeated.

Dubats, like Westfalls et al., fails to disclose a computer entity having a data storage device that is partitioned to provide a first amount of storage capacity. Moreover, none of Bolan et al., Westfall et

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al. or Dubats discloses increasing the partitioned capacity of a data storage device by using data, and in particular license key data including upgrade flag data. Accordingly, it is simply not obvious to one of ordinary skill in the art to arrive at the method of claim 1 by considering the disclosure of these three documents in combination.

Independent claim 7 distinguishes in an unobvious manner, *inter alia*, over the combination of Bolan et al. Westfall et al. and Dubats by requiring the step of determining whether an upgrade of licensed storage capacity can occur by reading the data that determines whether licensed data storage capacity can be increased. The Office Action implies Bolan et al. discloses this limitation in Fig. 4, the abstract and column 5, lines 5-14. However, there is no specific statement to this effect in these portions of Bolan et al., and Applicants do not understand how they are inherent. Explanation is in order.

To reject claim 17, the Office Action says the Bolan et al. abstract inherently provides a first level of data storage capacity according to first license data stored on a disk sector of said data storage device. The Examiner must explain why this step is inherent from the Bolan et al. abstract that fails to mention a disk sector, data storage capacity or license data, no less license data stored on a disk sector.

The Office Action fails to mention the claim 17 requirement for the disk sector where the first license data are stored, being inaccessible to an operating system of the computer entity including the data storage device including the disk sector.

The Office Action alleges, that column 5, lines 5-14 of Bolan et al. discloses a computer entity according to a second license data stored on the storage device, including the disk sector. The Examiner must explain the basis for this conclusion, since the relied on portion of Bolan et al. does not mention a computer entity including a disk sector or second license data, no less second license data, that enable the data storage capacity of the licensed first level to be modified.

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The Office Action admits Bolan et al. does not disclose modifying storage capacity. The reliance on Westfall et al. for the storage modifying feature is nonsense, as previously discussed. Reliance on Dubats for an operating system is irrelevant.

In view of the foregoing amendments and remarks, favorable reconsideration and allowance of the application are therefore deemed in order, and such action is respectfully requested.

To the extent necessary during prosecution, Applicants hereby request any required extension of time not otherwise requested and hereby authorize the Commissioner to charge any prescribed fees not otherwise provided for, including application processing, extension, and extra claims fees, to Deposit Account No. 08-2025.

Respectfully submitted,

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